

REMARKS

Claims 15-25 currently are pending.

Claims 15-18, 22-25 are rejected under 35 USC § 103(a) as being unpatentable over Stainmesse et al. (US 5,133,908). The examiner stated that absent unexpected results, it would have been obvious to one of ordinary skill in the art to have mixed the composition either in a batch, as suggested by Stainmesse et al., or continuously, as both are well known in the art. The examiner believes both processes result in a precipitation, wherein the suspension or colloid is converted into a dry powder.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

Applicants point out that Stainmesse et al. do not teach or suggest all the claim limitations of the rejected claims (15-18, 22-25). The examiner has not shown how the following limitation is taught or suggested by Stainmesse et al.: "...continuously in a mixing chamber **by spraying the two components as a compact jet into a mixing chamber.**" Therefore, the examiner has not set forth a *prima facie* case of obviousness.

The examiner also has not shown how there would be a reasonable expectation

of success in modifying Stainmesse et al. to teach or suggest the claimed invention. Reasonable expectation of success is one of the requirements for establishing a *prima facie* case of obviousness.

Applicants also believe the examiner has set forth an adequate motivation to modify the teachings in Stainmesse et al. Stainmesse et al. teaches that there is a need for moderate agitation dependent on the amounts utilized and no agitation is needed at all for smaller quantities (col. 4, lines 42-44). No person of ordinary skill in the art would be recommended to use "moderate agitation" for larger amounts to spray the two components as a compact jet into a mixing chamber. Proceeding contrary to the accepted wisdom of the prior art is strong evidence of nonobviousness. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 312, (Fed. Cir. 1993); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685, 687 (Fed. Cir. 1986). In view of this, applicants believe the examiner has not set forth a *prima facie* case of obviousness.

Claims 15-18, 22-25 are rejected under 35 USC § 103(a) as being unpatentable over List et al. (US 5,389,382). The examiner stated that absent unexpected results, it would have been obvious to one of ordinary skill in the art to have mixed the composition either in a batch, as suggested by List et al., or continuously, as both are well-known in the art. The examiner stated that both processes result in a precipitation, wherein the suspension or colloid is converted into a dry powder.

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First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

Applicant believe the examiner not set forth a *prima facie* case of obviousness regarding List et al. First, the examiner also has not shown how there would be a reasonable expectation of success in modifying List et al. to teach or suggest the claimed invention. Reasonable expectation of success is one of the requirements for establishing a *prima facie* case of obviousness.

Second, suggestion or motivation to modify List et al. to teach the elements of the rejected claims is not present. List et al. only relates to batch-wise production of the particle. Therefore, one of ordinary skill in the art will recognize that batch-wise operation disclosed by List et al. has to be followed by filtration to separate any coarse particles. (see examples 1 and 2 of List et al.). This shows that the teaching in List et al. would not lead to fine particles with uniform size without further steps.

Also, even though it may be known in principle that processes can be operated continuously, one cannot necessarily infer that for a specific process, desire results to be achieved by a continuous process only if the batch wise mode of operation has been disclosed in the references. Therefore, one of ordinary skill in the art would not conclude from List et al. that a process as presently claimed will avoid the additional

distinct step of separating coarse particles. Before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. *Ex parte Kranz*, 19 USPQ2d 1216, 1218 (BPAI 1990).

Claims 15-25 are rejected under 35 USC § 103 (a) as being unpatentable over List et al. (US 5,389,382) in view of Liversidge et al. (US 5,145,684). The examiner stated that absent unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of List et al. by substituting casin as taught by Liversidge for gelatin as the coating polymer because of the expectation of unexpected bioavailability and are useful in methods of treating mammals as taught by Liversidge et al.

Applicants' above arguments regarding List et al. applies here as well.

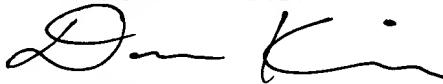
The present invention is directed to a specific continuous process. The examiner relies on Liversidge et al. for the teaching of an alternative coating polymer and that the polymer coating taught by Liversidge et al. can be used for both crystalline and amorphous drugs. Applicants believe examiner's argument is inapplicable since the presently claimed invention is directed to a specific continuous process. The presently claimed process relies on the principle that an active ingredient is first dissolved and then precipitated to obtain a nanoparticulate form. According to Liversidge et al., the active ingredient is not dissolved at all. Reduction in particle size is achieved by wet-grinding of a polymeric slurry. Therefore, one of ordinary skill in the

art would not combine the teachings of List et al. and Liversidge et al. to arrive at the claimed continuous process where the components are sprayed into the mixing chamber. Neither List et al. and Liversidge et al. teach anything regarding continuous operation of a process. Before obviousness may be established, the examiner must show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. *Ex parte Kranz*, 19 USPQ2d 1216, 1218 (BPAI 1990).

For the reasons expressed above, it is urged that the prior art references cited by the examiner either singly or in combination fail to anticipate or suggest the present invention as defined by the amended claims. Accordingly, a *prima facie* case of obviousness has not been established by the examiner, and the rejection under 35 USC § 103 should be withdrawn.

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Respectfully submitted,
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read 'Dan Kim', is written over the printed name.

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